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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91218973
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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<p>DONALD REID</p> <p style="text-align: right;">Opposer,</p> <p style="text-align: center;">v.</p> <p>MONSTER, INC.,</p> <p style="text-align: right;">Applicant.</p>	<p>Opposition No.: 91218973</p> <p>Application Nos.: 86048004; and 86047996;</p> <p>Marks: GODJ, GO DJ</p>
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APPLICANT’S TRIAL BRIEF ON THE MERITS

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Pursuant to 37 C.F.R. § 2.128, Applicant Monster, Inc. (“Monster”), hereby submits this brief in support of its applications for the marks GODJ and GO DJ, Application Serial Nos. 86048004 and 86047996, respectively.

I. STATEMENT OF THE CASE

The issues in this case are (1) whether Opposer has standing to bring this Opposition; and (2) whether Monster had a bona fide intent to use the marks GODJ and GO DJ, Application Serial Nos. 86048004 and 86047996, respectively, at the time of filing the intent-to-use applications on August 26, 2013. For the reasons set forth below, Monster believes that it has provided sufficient evidence to establish that (1) Opposer does not have standing to bring this Opposition; and (2) Monster had a bona fide intent to use the GODJ and GO DJ marks at the time it filed its intent-to-use applications.

A. BACKGROUND FACTS AND PROCEDURAL HISTORY

1. Partnership Between JD Sound and Monster.

JD Sound created a portable DJ system titled “PDJ.” (36 TTABVUE 13.) Chang “Robin” Lee (“Lee”) was the President of North American headquarters of JD Sound from 2012 to 2013. (36 TTABVUE 12.) His job duties included, among other things, “developing marketing channels, sales channels as well as partnerships.” (36 TTABVUE 13.) In mid-2013, and as part of Lee’s job duties, Lee created a strategy to partner with a larger brand in order to help market and sell the portable DJ system. (36 TTABVUE 13.) Around March of 2013, JD Sound, through Lee, engaged in discussions with Monster regarding a partnership based on the portable DJ system. (36 TTABVUE 13.) Lee specifically targeted Monster because JD Sound “needed a brand name in order to establish a strong presence in the marketplace,” and Monster was a leader in the industry. (36 TTABVUE 14, 148-149.) During March and April of 2013,

numerous discussions subsequently took place between Lee and various agents of Monster regarding the portable DJ system and a partnership between JD Sound and Monster. (36 TTABVUE 17-18, 22.) Finally, in the summer of 2013, a partnership was reached during a meeting which Lee attended. (36 TTABVUE 18.) Under the terms of the partnership, JD Sound would license to Monster the right to use the Monster mark and the Monster GO DJ mark for the portable DJ system and pay a royalty to Monster Products. (36 TTABVUE 18-20.)

2. Monster's Choice of the GODJ and GO DJ Marks.

While JD Sound and Monster discussed partnership in the spring and summer of 2013, discussions also began in March and April of 2013 regarding product development and modification, including changing the name of the portable DJ system. (36 TTABVUE 20-22.) Since Lee was very much involved in the project, he attended all of these discussions. (36 TTABVUE 20-22, 33.) By August 2013, and prior to Monster's filing of its three intent-to-use applications ("ITU Applications") on August 26, 2013, Noel Lee, the CEO of Monster, decided to name the product GO DJ, and plans were in place for marketing the product. (36 TTABVUE 21.) The marketing strategy, which Lee advised on, included various iterations of the GO DJ mark. (36 TTABVUE 25, 146.)

3. Monster's Applications and Use of the GODJ and GO DJ Marks.

Monster filed the above-referenced applications on August 26, 2013, seeking registration of the marks GODJ and GO DJ all for goods in IC 009. At the time of filing the trademark applications, Monster had intent to use the GODJ and GO DJ marks. (36 TTABVUE 94-95.) Since the filing of its ITU Applications, Monster has sold its portable DJ system under the marks GO DJ and GODJ. (36 TTABVUE 36-37, 51, 94, 137-145, 150-151.) JD Sound registered the domain name "MonsterGODJ.com" on September 17, 2013. (36 TTABVUE 42-43, 152-154; 34

TTABVUE 132-135.) Early website entries at www.monstergodj.com included news references indicating the portable DJ system was available for sale under the GODJ mark at Vestax Europe's webstore as early as September 1, 2013. (36 TTABVUE 51, 162-173; 34 TTABVUE 136-148.)

Once the GO DJ portable DJ system was launched, Monster planned to expand the product line to include related products that were a natural expansion for Monster for the portable DJ system. 19 TTABVUE 3. Monster is an industry leader in the field of audio and video cables and related electronic products, including headphones and speakers. 19 TTABVUE 3. Monster intended to use the successful GO DJ marks on products for which Monster is known and respected. 19 TTABVUE 3.

Since the filing of its ITU applications for GODJ and GO DJ, Monster has continued to use the marks through advertising and sales. (36 TTABVUE 36-37, 51, 137-145, 150-151; 34 TTABVUE 129-131.) As early as September 29, 2013, YouTube videos were created about Monster's GO DJ portable DJ system. (36 TTABVUE 174-186; 34 TTABVUE 149-161.) In October of 2013, Monster created a @MonsterGODJ twitter handle and began tweeting about the product. (36 TTABVUE 189; 34 TTABVUE 165-166.) As early as December of 2013, Monster launched the Monster GODJ facebook page and began posting about the product. (36 TTABVUE 187-188; 34 TTABVUE 162-164.) Finally, as early as November of 2013, Monster created the monstergodj Instagram account and began posting photos regarding the GODJ portable DJ system. (37 TTABVUE 2-15; 34 TTABVUE 167-181.) Monster launched the GODJ eCommerce website on November 18, 2013, where the portable DJ was sold under the GO DJ and GODJ marks. (36 TTABVUE 35, 54-56, 137-145, 150-151, 155-159; 34 TTABVUE 129-131.) Monster continues to sell the portable DJ system on its website at

www.monstergodj.com. (36 TTABVUE 150-151; 34 TTABVUE 129-131.)

4. Opposer's Marks

Opposer filed a Notice of Opposition on October 20, 2014 opposing the registration of Monster's applications and commencing the present opposition proceeding (the "Opposition"). (1 TTABVUE.) At the time of filing the Opposition, Opposer had filed four (4) applications seeking registration of the marks GODJ and GO DJ: Application Serial Number 86397296 filed on September 17, 2014 for GODJ in IC 035 for numerous services (the "296 Application"); Application Serial Number 86335783 filed on July 14, 2014 for GODJ in IC 042 for numerous services (the "783 Application"); Application Serial Number 86332994 filed on July 10, 2014 for GODJ in IC 041 for numerous services (the "994 Application"); and Application Serial Number 86340839 filed on July 17, 2014 for GO DJ in IC 038 for numerous services (the "839 Application"). The Opposition cited only one of these applications, the 296 Application. (1 TTABVUE 2.) In his opposition, Opposer claimed standing based on the fact that he is a user in commerce of the marks GODJ and GO DJ, and the belief that the registration of his 296 Application will be refused due to Monster's applications. (1 TTABVUE 2.)

Since the filing of the Opposition, on October 20, 2014, Notices of Publication were filed for the 994, 839 and 296 Applications on November 12, 2014, and the 783 Application was approved for registration on October 23, 2014. Notices of Allowance thereafter issued for the 994, 783 and 296 Applications on January 27, 2015, and on March 10, 2015, Opposer's trademark for GODJ as identified in the 783 Application was registered under Registration Number 4699143. Opposer's relevant applications at the time of his filing of the Opposition, and their statuses, are summarized in the chart below.

Mark	Serial Number	Registration Number	Filing Date	Registration Date	Goods and Services
GODJ	86332994		July 10, 2014	Notice of Publication issued: November 12, 2014 Notice of Allowance issued: January 27, 2015	IC 041
GODJ	86335783	4699143	July 14, 2014	Approved for Registration: October 23, 2014 Registered: March 10, 2015	IC 042
GO DJ	86340839		July 17, 2014	Notice of Publication Issued: November 12, 2014 Notice of Allowance issued: January 27, 2015	IC 038
GODJ	86397296		September 17, 2014	Notice of Publication Issued: November 12, 2014 Notice of Allowance issued: January 27, 2015	IC 035

After commencing this current action, Opposer filed five (5) more applications, two (2) of which include goods that are in direct competition with Monster's marks, seeking registration of the marks GODJ, GODJR, GODDJ and GODDJ: Application Serial Number 86467434 filed on December 1, 2014 for GODDJ in IC 035 for numerous services (the "434 Application"); Application Serial Number 86468202 filed on December 1, 2014 for GODJ in IC 009 for numerous services, including competing goods and services (the "202 Application"); Application Serial Number 86491600 filed on December 29, 2014 for GODJR in IC 009 for numerous services, including competing goods and services (the "600 Application"); Application Serial Number 86726428 filed on August 17, 2015 for GODDJ in IC 042 for numerous services (the

“428 Application”); and Application Serial Number 86726423 filed on August 17, 2015 for GODDJ in IC 038 for numerous services (the “423 Application”). The 434 Application and the 202 Application are currently suspended due to the current litigation, while the 600 Application is suspended due to Application Serial No. 86257197 filed by DJDJ, Inc. on April 20, 2014 for GOD JR in IC 009. The 428 Application and the 423 Application were published for opposition on July 19, 2016, indicating that Notices of Allowance will soon issue for these applications.

Opposer’s relevant applications after the filing of the Opposition, and their statuses, are summarized in the chart below.

Mark	Serial Number	Registration Number	Filing Date	Registration Date	Goods and Services	Comments
GODDJ	86467434		December 1, 2014		IC 035	Currently suspended because of Monster’s GODJ application and current litigation.
GODJ (Owner is GODJ Entertainment Network, LLC)	86468202		December 1, 2014		IC 009 – computer software	Currently suspended because of current litigation.
GODJR	86491600		December 29, 2014		IC 009 - cases for audio speakers; audio speakers; and headphones	Currently suspended because Application Serial No. 86257197 filed by DJDJ, Inc. on April 20, 2014 for GOD JR in IC 009

GODDJ	86726428		August 17, 2015	Published for Opposition 7/19/16	IC 042	
GODDJ	86726423		August 17, 2015	Published for Opposition 7/19/16	IC 038	

5. Opposer's Claims

Throughout the proceedings, Opposer has explicitly stated that he is not claiming likelihood of confusion between his and Monster's marks. (34 TTABVUE 53-54, 58, 65-66.) Opposer has also emphatically stated that the 783 Application, the 994 Application, and the 839 Application are not a subject of this proceeding. (34 TTABVUE 14-30.)

B. DESCRIPTION OF THE RECORD

The evidence of records consists of:

1. The pleadings in this proceeding;
2. The file history of the subject applications and related applications;
3. Monster's following Notices of Reliance filed during its testimony period:
 - i. Defendant's Notice of Reliance filed on April 18, 2016 and including Exs. 1-3, 5, 6, 9, 10, and 11-13. (34 TTABVUE.)
4. Opposer's following Notices of Reliance filed during his testimony period:
 - i. Plaintiff's Notice of Reliance filed on February 15, 2016 and including Exhibits A-H. (32 TTABVUE; 33 TTABUVUE.)
5. The Chang "Robin" Lee Deposition and Exhibits. (36 TTABVUE; 37 TTABVUE.)

II. STATEMENT OF ISSUES

- I. Whether Opposer has standing to bring this Opposition.

II. Whether Monster had a bona fide intent to use the marks GODJ and GO DJ at the Application Serial Nos. 86048004 and 86047996, respectively, at the time of filing the intent-to-use applications on August 26, 2013.

III. ARGUMENT

A. LEGAL STANDARD FOR STANDING

Section 13 of the Lanham Act sets forth who has standing to bring an opposition before the Patent and Trademark Office. “Any person who believes that he would be damaged by the registration of a mark upon the principal register . . . may . . . file an opposition in the Patent and Trademark Office[.]” 15 U.S.C. § 1063(a). In order to show “damage,” and establish standing to bring an opposition, “an opposer must meet two judicially-created requirements . . . the opposer must have a ‘real interest’ in the proceedings and must have a ‘reasonable’ basis for his belief of damage.” *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999). In this case, Opposer cannot meet the requirements to establish standing as Opposer’s alleged basis for standing in this case is moot.

1. Opposer Has Failed to Prove that He Will be Damaged as Alleged by Registration of Monster’s Marks.

Opposer’s only basis for standing is his assumption that Monster’s marks would block the registration of his 296 Application. (1 TTABVUE.) Not only has the registration of his 296 Application not been blocked, a Notice of Allowance has issued for the ‘296 Application, and Opposer has already filed a SOU Extension Request. Without evidence to support his belief that his 296 Application will be blocked, and with evidence that supports the high likelihood of registration of his 296 Application, Opposer’s belief of damage is unreasonable. Opposer does not have standing to bring the opposition.

In order to have “real interest” sufficient to establish standing, “an opposer to a

registration is required to have a legitimate personal interest in the opposition . . . [T]he opposer must have a direct and personal stake in the outcome of the opposition.” *Ritchie*, 170 F.3d at 1095. Here, while Opposer is seeking registration of a similar mark, under section 13 of the Lanham Act, the allegations in support of Opposer’s belief of damage must have a “reasonable basis in fact.” *Ritchie*, 170 F.3d at 1098. This is where Opposer’s claim of standing falls short.

“A real interest in the proceeding and a reasonable belief of damage may be found . . . where plaintiff pleads (and later proves) . . . [that] [p]laintiff has been refused registration of its mark because of defendant’s registration, or has been advised that it will be refused registration when defendant’s application matures into a registration, or has a reasonable belief that registration of its application will be refused because of defendant’s registration.” TBMP § 309.03(b) (2015); *see Saddlesprings, Inc. v. Mad Croc Brands, Inc.*, 104 USPQ2d 1948 (TTAB 2012) (Petitioner’s intent-to-use application had been refused based on respondent’s registrations, which was sufficient to establish standing.).

Opposer has failed to prove that a reasonable belief of damage may be found. First, Opposer cannot prove that his registration was refused. To the contrary, in Opposer’s Responses to Requests for Admission (“Responses to RFAs”), Opposer admitted that the registration of his 296 Application was not refused. (34 TTABVUE 9-10.) Second, Opposer has provided no evidence that he was advised that his mark would be refused registration when Monster’s applications mature into registrations. (34 TTABVUE 72.) Third, Opposer cannot establish that he has a reasonable basis to believe that his registration will be refused based on Monster’s marks as the application has been allowed.

In Opposer’s Responses to Special Interrogatories, specifically response to Special Interrogatory number four, Opposer listed all the facts that support his claim that the registration

of his 296 Application for GODJ is likely to be refused. (34 TTABVUE 52-53.) “Monster’s mark had an earlier filing date and hence earlier constructive use date than the constructive use date of Opposer’s 296 mark and the marks are identical or almost identical in appearance and connotation.” *Id.* Because Opposer has received a Notice of Allowance for his 296 Application, there is no basis for Opposer’s alleged belief that his 296 Application will be refused.

Opposer has not claimed any other basis for belief of damage that would support standing. In Opposer’s Responses to Special Interrogatories, Opposer stated numerous times that “Opposer has claimed no ground regarding likelihood of confusion.” (34 TTABVUE 48-73.) It is clear that Opposer’s claim of standing is based solely on his belief that his 296 Application would be rejected. In fact, Opposer’s cited application, as well as the other applications pending at the time of the filing of the Opposition proceeding, have not been blocked and have proceeded to registration or allowance.

Similarly, the trademark applications filed by Opposer after the initiation of this Opposition (the 434, 202, 600, 428 and 423 Applications) have no impact on Opposer’s standing because they do not establish Opposer’s reasonable belief of damage at the time of the filing of the Opposition. Furthermore, Opposer only filed these trademark applications in an attempt to gain standing once he realized that Monster’s applications would not block Opposer’s applications filed before his Opposition, including the 296 Application. On October 23, the 783 Application was approved for registration.¹ On November 12, 2014, the USPTO sent Opposer Notices of Publication for the 994, 839 and 296 Applications. After receiving the Notices of Publication and becoming aware that his applications were not likely to be blocked by Monster’s applications and therefore he would not have standing for this Opposition, Opposer filed the 434, 202, 600, 428 and 423 Applications. Specifically, unlike his previous applications, the 202 and

¹ The USPTO subsequently sent Opposer a Notice of Publication for the 783 Application on December 3, 2014.

600 Applications were in the same class of goods as Monster's applications, and were for competing goods and services. Opposer is attempting to create a likelihood of confusion in order to gain standing. Ultimately, Opposer's plan is to block Monster's applications for unrelated goods, and then, through these additional applications, gain a registration for similar marks over competing goods. Opposer should not be allowed to use such tactics in order to gain standing to bring the Opposition.

This is not a case like *Lipton Industries v. Ralston Purina Co.*, 670 F.2d 1024, 1028 (CCPA 1982), where the Court stated: "Thus, to have standing in this case, it would be sufficient that appellee prove that it filed an application and that a rejection was made because of appellant's registration." To the contrary, Opposer does not have standing because Opposer's applications were not likely to be rejected, and that was Opposer's sole basis for alleging standing. *Lipton Industries v. Ralston Purina Co.*, 670 F.2d 1024, 1028 (CCPA 1982). Because Opposer cannot establish a reasonable basis for his belief of damage, Opposer does not have standing to bring his opposition.

B. LEGAL STANDARD FOR BONA FIDE INTENT TO USE

Lanham Act § 1(b)(1) states that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce" may apply for registration of the mark. 15 U.S.C. § 1051(b). It is settled that "... the determination of whether an applicant has a bona fide intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances." *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1357 (TTAB 1994). An applicant cannot rely on mere subjective intent about a state of mind, but must demonstrate some evidence of the intent to use. For example in the Lane case, the Board stated:

With respect to the activities of applicant's predecessor, the evidence shows that applicant's principal had succeeded in marketing tobacco in the United States by locating a non-U.S. licensee ... which exported tobacco to the United States under the previous SMUGGLER mark. This evidence is relevant because it establishes that applicant's principal was engaged in the tobacco marketing business, including the export of tobacco to the United States under the previous SMUGGLER mark. When viewed in the context of this prior experience and success in the relevant industry, we find that applicant's efforts to obtain a licensee for the new SMUGGLER mark are consistent with and corroborative of applicant's claimed bona fide intention to use the new mark in commerce.

Id.

1. Monster Had a Bona Fide Good Faith Intent to Use the Marks in Commerce at the Time its Intent to Use Applications Were Filed.

Opposer's only basis for his opposition is his assumption that Monster lacked a bona fide intention to use the marks in commerce. (1 TTABVUE 5.) In support of this mistaken assumption, Opposer references Monster's prior ITU applications for other marks, and incorrectly extrapolates that Monster therefore did not intend to use the GODJ and GO DJ marks. (1 TTABVUE 6.) Monster's previous applications referenced by Opposer are irrelevant to the current opposition. In fact, when asked about these applications in Opposer's Requests for Admission, Monster objected based on irrelevance. (32 TTABVUE 17-20.) As Monster has objected to the relevance of those applications from the very beginning and Opposer has not submitted evidence of relevance, all references to those applications should be stricken and given no weight. Furthermore, it would be unreasonable, not to mention burdensome, to require Monster to produce evidence in this unrelated action regarding Monster's bona fide intent to use these marks at the time Monster filed the corresponding applications.

Not only are Monster's previous applications referenced by Opposer irrelevant to the current opposition, but Opposer reaches an illogical conclusion. Even if there were past applications for marks unrelated to this proceeding that were not used, that is not evidence that

Monster had no intent to use the GODJ and GO DJ marks at the time the corresponding applications were filed. In fact, Monster did intend to use the marks at the time of filing.

This is not a case of an applicant making mere subjective statements that the applicant had some future plans to use the mark on some future product. Monster has demonstrated that at the time of filing its ITU applications for GODJ and GO DJ, Monster had a bona fide intent to use the marks in commerce and had the ability to use the marks, which is supported by evidence demonstrating such intent and ability.

Prior to the filing of its ITU applications, Monster engaged in discussions with JD Sound, specifically Lee, to market the portable DJ system, PDJ. (36 TTABVUE 13.) The portable DJ system already existed as a product, and Monster negotiated with the previous product owner to take over marketing and producing the product, with the new GO DJ branding chosen in mid-2013 and before the ITU Applications were filed. (36 TTABVUE 13, 17-18, 21-22.) Monster is an industry leader and has been producing products in the consumer electronics field since it was founded in 1979. (19 TTABVUE 3.)

Monster filed the above-referenced applications on August 26, 2013, seeking registration of the marks GODJ and GO DJ all for goods in IC 009. At the time of filing the trademark applications, Monster had intent to use the GODJ and GO DJ marks. (36 TTABVUE 94-95.) On September 1, 2013, less than a week after filing its ITU applications, Monster's website stated that GODJ was available for sale at Vestax Europe webstore. (36 TTABVUE 51, 162-173; 34 TTABVUE 136-148.) On September 17, 2013, about three weeks after filing its ITU applications, JD Sound registered the MonsterGoDj.com domain name. (36 TTABVUE 42-43, 152-154; 34 TTABVUE 133-135.) These events, so soon after submission of the ITU applications clearly demonstrate that Monster had intent to use the marks in commerce. This

evidence coupled with Lee's statements confirms that Monster had an intent to use the marks at the time Monster filed its intent to use applications.

Once the GO DJ portable DJ system was launched, Monster planned to expand the product line to include related products that were a natural expansion for Monster for the portable DJ system. 19 TTABVUE 3. Monster is an industry leader in the field of audio and video cables and related electronic products, including headphones and speakers. 19 TTABVUE 3. Monster intended to use the successful GO DJ marks on products for which Monster is known and respected. 19 TTABVUE 3.

Not only did Monster intend to use the marks in commerce when it applied for the trademarks, it has followed through with that intent by actually using the marks in commerce. (36 TTABVUE 94-95.) Since the filing of its ITU applications for GODJ and GO DJ, Monster has continued actual use of the marks in commerce through advertising and sales. (36 TTABVUE 36-37, 51, 137-145, 150-151; 34 TTABVUE 129-131.) As early as September 29, 2013, YouTube videos were created about the GO DJ. (36 TTABVUE 174-186; 34 TTABVUE 149-161.) In October of 2013, Monster created a @MonsterGODJ twitter handle and began tweeting about the product. (36 TTABVUE 189; 34 TTABVUE 165-166.) As early as December of 2013, Monster launched the Monster GODJ facebook page and began posting about the product. (36 TTABVUE 187-188; 34 TTABVUE 162-164.) Finally, as early as November of 2013, Monster created the monstergodj Instagram account and began posting photos regarding the GODJ. (37 TTABVUE 2-15; 34 TTABVUE 167-181.) Monster launched the GODJ eCommerce website on November 18, 2013, where the portable DJ was sold under the GO DJ and GODJ marks, and Monster continues to sell the GODJ system on its website. (36 TTABVUE 35, 54-56, 94, 137-145, 150-151, 155-159; 34 TTABVUE 129-131.) While Monster

intended to use several variations of the phonetic “go dj” in connection with its marketing and sales of the portable disc jockey system, after use of the various marks, it is now using just GO DJ (with design) and GODJ. (36 TTABVUE 25, 146.)

2. The Deposition Testimony of Chang “Robin” Lee is Admissible.

Lee has personal knowledge of the matters to which he testified. Lee was the President of North American headquarters of JD Sound from 2012 to 2013. (36 TTABVUE 12.) His job duties included, among other things, “developing marketing channels, sales channels as well as partnerships.” (36 TTABVUE 13.) It was Lee’s strategy to partner with Monster in order to help market and sell the portable DJ system, and Lee was present during the discussions with Monster regarding such a partnership. (36 TTABVUE 13, 17-18, 21.) The partnership was reached during a meeting that Lee attended. (36 TTABVUE 18.) Since Lee was very much involved in the portable DJ system project, as well as the marketing and advertising of the product, Lee also attended the discussion regarding product development and modification, including changing the name of the portable DJ system. (36 TTABVUE 20-22, 33.) In addition, Lee has personal knowledge of the exhibits introduced during the deposition testimony either because he was involved in organizing and bringing about the actions described in the exhibits, or he personally created or was present during the creation of some of the exhibits. (36 TTABVUE 30, 33, 38-39, 41-43, 46-47, 62, 65-68, 81, 85-86.)

Lee’s testimony and exhibits are not hearsay. Under Rule 801 of the Federal Rules of Evidence, hearsay is defined as “a statement that: (1) the declarant does not make while testifying at the current trial or hearing; and (2) a party offers in evidence to prove the truth of the matter asserted in the statements.” Fed. R. Evid. 801(c). “Statement” is further defined as “a person’s oral assertion, written assertion, or nonverbal conduct, if the person intended it as an

assertion.” Accordingly, verbal acts and statements that are not offered to prove the truth of the matter asserted are not hearsay. The exhibits introduced during Lee’s deposition testimony are not being admitted for the truth of the matter asserted, but rather for what they show – that Monster intended to use and did use the marks in commerce. Furthermore, regarding the exhibits that contain website printouts, internet printouts submitted as exhibits to testimony are not hearsay. *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1735 (TTAB 2012); (36 TTABVUE 150-159, 162-189; 37 TTABVUE 2-15; 34 TTABVUE 129-181.)

If for some reason Lee’s testimony is considered hearsay, it is still admissible under at least one of the exceptions to the hearsay rule. For most of the evidence submitted, it was Monster and JD Sound’s regular practice for someone with knowledge to create records of events at or near the time they occurred, and to keep copies of those records. (36 TTABVUE 30-31, 33-34, 38, 40-41, 43, 46, 48, 59, 79-80, 82, 84.) This would mean that the exhibits are business records which are considered an exception to the hearsay rule. Fed. R. Evid. 803(6). Furthermore, most of Lee’s testimony shows circumstantial evidence of his and Monster’s state of mind and intent, which is an exception to the hearsay rule. Fed. R. Evid. 803(3).

C. MONSTER’S ITU APPLICATIONS

1. Monster GO-DJ Mark is a Mark at Stake in this Proceeding.

The use of GO-DJ in connection with the portable DJ system is an acceptable variation of the GODJ and GO DJ marks. For showing use of marks, a specimen drawing must be a “substantially exact representation of the mark as used on or in connection with the goods/services.” TMEP § 807.12(a). When defining “substantially exact representation,” the Trademark Manual of Examining Procedure states that “[e]xtraneous, non-distinctive”

punctuation that appears on the specimen may be omitted from the mark on the drawing[.]” *Id.* § 807.12(a)(i). The determination of whether punctuation is irrelevant is whether the commercial impression of the mark is changed by the inclusion or exclusion of the punctuation. *Id.* For example, the mark “HOME RUN” on the specimen is considered a “substantially exact representation” of the mark HOME RUN in the drawing since the inclusion of the quotation marks in the specimen do not alter the commercial impression of the mark. *Id.* at § 807.12(a)(iii). Here, the addition of punctuation, a dash, between the GO and DJ does not alter the commercial impression of the mark. Therefore, GO-DJ is a “substantially exact representation” of GODJ and GO DJ.

Monster’s pictures establish the use of the GODJ and GO DJ marks on the portable DJ system and its cases. The GODJ and GO DJ marks themselves are shown on the cases containing the portable DJ system. (36 TTABVUE 137-145.) In addition, the GO-DJ mark appears on the screen of the portable DJ system itself once the power is turned on. (36 TTABVUE 174-186.) Furthermore, the introductory manual, as well as the New York Times article reference GO-DJ, which is an acceptable variation of GODJ and GO DJ under the Trademark Manual of Examining Procedure section 807.12(a). (36 TTABVUE 137-145, 150-151; 34 TTABVUE 129-131.)

2. The Portable DJ Equipment is One of the Goods in Monster’s Applications.

Monster’s portable DJ system is among the applied-for goods in its intent-to-use applications. Monster’s applications list the following as goods or services: “[c]omputer software and hardware for music mixing” and “cases for consumer electronic products, namely, cases for . . . portable DJ equipment.” The portable DJ system is composed of hardware for music mixing such as an electronic screen, data transfer/power transfer USB ports, knobs for

analog controls and mixing functions such as cross-fading, and audio jacks. (36 TTABVUE 26-27.) In fact, Monster is “the first to bring touch screen and analog hardware together for DJ and music production functionalities.” (36 TTABVUE 27.) The portable DJ system consists of a software component since, as a “stand-alone DJ controller,” it includes “proprietary software for music recording, production, mixing and other functions.” ((36 TTABVUE 27.) Lastly, the device comes in GODJ labeled cases “with velvet-like packaging material.” (36 TTABVUE 27, 137-145.)

3. Monster Can Amend its ITU Applications If Necessary.

If the Board determines that Monster has not fully established intent to use for all goods listed in its ITU Applications, Monster should be allowed to amend its ITU applications to remove those goods for which the Board rules that Monster has not met its burden of proof. Amendment of an application is more appropriate than voiding the entire application. *See Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 USPQ2d 1696, *1 (TTAB 2006). “[A]n application will not be deemed void for lack of a bona fide intention to use absent proof of fraud, or proof of a lack of bona fide intention to use the mark on all of the goods identified in the application, not just some of them.” *The Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, *2 (TTAB 2007). A successful claim of lack of bona fide intent knocks out only the particular goods or services as to which there was no intent, not the entire class. *Id.* (“contrary to opposer's contention, an application will not be deemed void for lack of a bona fide intention to use absent proof of fraud, or proof of a lack of bona fide intention to use the mark on all of the goods identified in the application, not just some of them. Thus, we will decide this issue in terms of whether the items, if any, for which opposer has shown applicant's lack of bona fide intention to use the mark should be deleted from the application.”); *see also Syndicat Des*

Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes, 107 USPQ2d 1930, *2 (TTAB. 2013), *15 (T.T.A.B. June 14, 2013). The more appropriate remedy is deleting “items, if any, for which opposer has shown applicant’s lack of bona fide intention to use the mark,” and dismissing the opposition for the goods and services where bona fide intent to use is shown. *The Wet Seal, Inc.*, 82 U.S.P.Q.2d at *2; *Pasquier DesVignes*, 2013 WL 5407284 at *15.

III. CONCLUSION

Based on the foregoing, Monster respectfully requests that the Board allow its applications to proceed to registration.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing Applicant's Motion for Summary Judgment has been served by electronic mail pursuant to agreement on this 31st day of August, 2016, upon the following:

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